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09/533,904 03/21/00 KETTUNEN

A 10-1304

EXAMINER

IM22/0307

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Arlington VA 22201-4714

NGUYEN, T
ART UNIT

PAPER NUMBER

1731
DATE MAILED:

03/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/533,904

Applicant(s)

KETTUNEN

Examiner

Dean T. Nguyen

Group Art Unit

1731



☒ Responsive to communication(s) filed on Dec 18, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-46 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 1-21 is/are allowed.

☒ Claim(s) 22-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

REJECTION
FINAL

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DETAILED ACTION

Oath/Declaration

1. The Oath/Declaration fails to comply with the requirements of 37 CFR 1.175 (a) (1) by failing to identify specifically what the error is. The statements of items .4) "claiming less than I had a right to claim in '856" and .5) in the Declaration are not acceptable since they are not specific, i.e., "temperature of less than 200°C" instead of "in the range of 150-175°C". Also, applicant must point out the differences between the original claims and the new claims. ✓ ok

2. The Declaration does not state that "all errors being corrected in the reissue application up to the time of the filling of the oath or declaration arose without any deceptive intention on the part of the applicant" (37 CFR 1.175 (a)(20) or language equivalent thereto). The statement of item (8) is not acceptable. ✓

Claim Rejections - 35 USC § 112

3. Claims 22-43, 44-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1) In claim 22, the step of Treating (Heating) in Zone II of US '856 can not be considered as equivalent to step of Cooking in Zone B of US '414. The treating step of US '856 is conducted in the temperature of 120-160°C, preferably 135-145°C, which appears to be below the conventional cooking temperature of 150-170°C, which is shown in the cooking step B of US

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'414. The comparison on Attachment A, claim 1, last part has been reviewed but it's not clear from Fig. 2 (stages I and II or II and III) and col. 13, how they provide an equivalent teachings of having 1st and 2nd cooking zone wherein the second EA concentration is between about 8 to about 8 g/l greater than the 1st EA concentration. Moreover, on Fig. 10, US '856 shown another alternative of the cooking process of Fig. 2 by having 2 pre-treatment stages followed by 2 cooking stages, wherein the effective alkali (EA) of the 2nd cooking zone (CC-COOK) is between 20-30 g/l and the 1st cooking zone (COOKING) is between 25-35 g/l, which is not about 8-120 g/l greater than the EA of the first zone.

2) The teachings of the following dependent claims 25-33, 35, 38-43 are not disclosed in the original specification. The teachings of claims 44-45 are not included in the original specification.

4. Claims 22-46 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

1) In claim 22, the step of Treating (Heating) in Zone II of US '856 can not be considered as equivalent to step of Cooking in Zone B of US '414. The treating step of US '856 is conducted in the temperature of 120-160°C, preferably 135-145°C, which appears to be below the conventional cooking temperature of 150-170°C, which is shown in the cooking step B of US '414. The comparison on Attachment A, claim 1, last part has been reviewed but it's not clear from Fig. 2 (stages I and II or II and III) and col. 13, how they provide an equivalent teachings of

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having 1st and 2nd cooking zone wherein the second EA concentration is between about 8 to about 8 g/l greater than the 1st EA concentration. Moreover, on Fig. 10, US '856 shown another alternative of the cooking process of Fig. 2 by having 2 pre-treatment stages followed by 2 cooking stages, wherein the effective alkali (EA) of the 2nd cooking zone (CC-COOK) is between 20-30 g/l and the 1st cooking zone (COOKING) is between 25-35 g/l, which is not about 8-120 g/l greater than the EA of the first zone.

2) The teachings of the dependent claims 25-33, 35, 38-43 are not disclosed in the original specification. The teaching of claims 44-45 are not disclosed in the original specification.

Response to Arguments

5. Applicant's comments filed 3/21/00 have been fully considered but they are not persuasive.

6. Applicant's comment concerning the rejection of sub-paragraph 2) with respect to the similarity of the Treating zone II and Cooking zone III on Fig. 2 of US '856 to Cooking zone 1 (B) and 2 (C) is not persuasive for the following reasons: col. 9-10 of '856 teaches that the impregnated chip slurry is heated with hot cooking liquor in the temperature range of 120-160°C from 5-360 minutes (see col. 9, line 25 (or 9:25)), discharging from the impregnation vessel and heated to cooking temperature and passed to a second vessel or digester for cooking (see 9:56-69), and during the discharge from the impregnation vessel, the chip and liquor slurry is exposed to cooking liquor essentially at full cooking temperature, 140-180°C (see 10:1-5). It appears from the indicated teachings above that stage II of Fig. 2 is primarily a "heating stage" to cooking

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temperature since the entrained slurry leaving stage II contains “chip and liquor slurry” and not cooked chips or pulp/fibers which indicates full cooking step has taken place yet. Applicant’s comments on page 6-7 of the response are not persuasive for the same reasons set forth above. Even though stage II appears capable of heating the slurry to cooking temperature and operating in cooking condition, the teachings on col. 9 to col. 10, lines 1-5 indicate that chip remains in form and the treating stage is merely a heating stage to cooking temperature or cooking conditions.

Applicant’s response for the determination of the effective alkali concentration of each zone and the difference between the first cooking zone and second cooking zone is not found persuasive because: a) Fig. 2 is used in Attachment A of the pre-response to indicate the concentration difference in the claim, b) it’s not clear the relationship between Fig. 2 and Fig. 10 of the reissue case ? Are they related so that the teachings in one figure can be used in other figure? (c) the determination of equivalent concentration of claim 1 on Attachment A, 2nd page is not clear, (d) there is no specific teaching in the specification concerning the concentration of effective alkali in the first cooking zone and second cooking zone and the derivation of the concentration difference used by the applicant on pages 8-9 of the “Request For Consideration” is not persuasive since it’s not clear whether they actually reflect the true concentration of the cooking zone 1 and 2 as claimed. Moreover, it appears that applicant does not use normal condition to derive the concentration figure. Furthermore, it’s not clear whether the higher end of

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the limitation, about 120 grams/liter, can be met using the normal operating conditions as shown in the reissue case.

7. Applicant's comment concerning the dependent claims are not persuasive since the arguments over the independent claim 1 is not persuasive and the limitations in the dependent claims depend on the 2nd cooking zone. Furthermore, the argument H-Factor issue is not persuasive in view of lack of sufficient objective evidence (calculation sheet) to ensure that the H-Factor of US '414 is taught in US '856. Submission of the calculation for H-Factor is requested.

8. Applicant's comment concerning the rejection of sub-paragraph 1) of Office Action (8/18/00) is persuasive and the rejection is withdrawn.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Allowable Subject Matter

10. Claims 1-21 are allowed since they are the original claims as allowed in the patent.

11. When filing a FAX in Group 1300, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dean T. Nguyen whose telephone no. is (703) 308-2053. The examiner can normally be reached on Monday-Friday @ 7:00-4:00 PM (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stan Silverman, can be reached on (703) 308-3837. The fax phone number for this group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose tel. No. is (703) 308-0651.

dtn


DEAN T. NGUYEN
PRIMARY EXAMINER